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Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

\*1 EX PARTE D. SCOTT PAUL, GREGG S. SCHMIDTKE, PAUL COFFIN, AND LESLIE G. CHRISTIE

Appeal No. 1998-2114

Application No. 08/491,286

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

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HEWLETT-PACKARD CO.

P.O. BOX 10301

PALO ALTO, CA 94303-0890

Before HAIRSTON, JERRY SMITH, and BARRETT

Administrative Patent Judges.

HAIRSTON

Administrative Patent Judge.

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ON BRIEF

### DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 16. Claim 17 has been allowed.

The disclosed invention relates to a method and apparatus for inserting a media cartridge into a media cartridge storage and handling system.

Claims 1 and 13 are illustrative of the claimed invention, and they read as follows:

1. A media cartridge insertion apparatus for a media cartridge storage and handling system for use in association with a media cartridge of the type having a rear end portion which is adapted to be inserted into a media drive and having a forward end portion which is adapted to be grasped by a human operator for handling the cartridge comprising:

a) a housing supporting a cartridge carrier, said housing having a forward end portion and a side portion and having a housing longitudinal axis, said housing having a forward opening for enabling hand-insertion and hand-removal of cartridges by a human operator and having a side opening for enabling machine-insertion and machine-removal of cartridges by a mechanized cartridge handling apparatus; and

b) said cartridge carrier being angularly displaceable relative to said housing, said cartridge carrier having a central

longitudinal axis and having forward and rear end portions which are adapted to be positioned in corresponding adjacent relationship with the forward and rear end portions of a cartridge received therein; said cartridge carrier having a forward end opening adapted to enable longitudinal insertion and removal of cartridges from said cartridge carrier; said cartridge carrier comprising a first operating position associated with hand-insertion and hand-removal of cartridges, wherein said forward end portion of said cartridge carrier is positioned proximal said forward end portion of said housing; said cartridge carrier having a second operating position associated with machine-insertion and machine-removal of cartridges, wherein said forward end portion of said cartridge carrier is positioned proximal said side portion of said housing;

c) a track having a forward end portion and a rear end portion fixedly associated with said housing and operably associated with said cartridge carrier.

13. A method of inserting a media cartridge into a media cartridge storage and handling system whereby said cartridge is transferred from a first operating position associated with hand-insertion and hand-removal of cartridges to a second operating position associated with machine-insertion and machine-removal of cartridges comprising the steps of:

\*2 (a) locating a cartridge carrier at said first operating position;

(b) inserting said cartridge into said cartridge carrier;

(c) moving said cartridge carrier to an intermediate position between said first and second operating positions;

(d) checking for proper insertion of said cartridge in said cartridge carrier at said intermediate position.

The references relied on by the examiner are:

Jenkins et al. (Jenkins) 4,271,440 Jun. 2, 1981

Christie et al. (Christie) 5,062,093 Oct. 29, 1991

Permut 5,517,473 May 14, 1996

(effective filing date of Aug. 6, 1993)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Christie.

Claims 1 through 11 and 13 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Permut.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Christie in view of Jenkins.

Claims 12 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Permut in view of Jenkins.

Reference is made to the briefs (paper nos. 11, 13 and 19) and the answers (paper nos. 12 and 18) for the respective positions of the appellants and the examiner.

#### OPINION

The obviousness rejections of claims 1 through 16 are reversed.

In the statement of the rejection of claim 1, the examiner indicates (answer, page 5) that:

The main difference between the claimed invention and Christie et al[.] is that the claims set forth a side opening and the patent teaches a rear opening. This difference would have been obvious to one having ordinary skill since the cartridge of Christie et al[.] passes through the claimed orientation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the rear opening of Christie et al[.] on a side portion of the housing. The motivation would have been: providing the opening on the side of the housing as opposed to the rear would have resulted through routine experimentation and optimization, lacking any unobvious or unexpected results. Further, this type of difference would appear to deal with a mere shifting location of parts, namely the opening, which has been held to involve only routine skill, see In re Japikse, 86 USPQ 70 (CCPA 1950) .

\*3 Appellants argue (brief, page 17) that although the cartridge in Christie may pass through a side orientation, it can

be seen in Christie (Figure 2) that "the housing 30 includes solid sidewalls (generally in the location of reference numerals 102, 104) which have no openings whatsoever." In response to the examiner's statement that the claimed invention involved nothing more than "routine experimentation and optimization," appellants argue (brief, page 20) that:

Appellants' invention, thus, is specifically intended to address a disadvantage of the Christie et al. system, i.e., that the window must be located on a surface that is positioned 90 degrees from the user interface surface. Appellants' invention, as recited in Claim 1, solves this problem by providing an insertion apparatus having a housing with a side opening. Accordingly, contrary to the Examiner's assertion, appellants' provision of a side opening is not "lacking any unobvious or unexpected results".

With respect to the citation of Japikse, appellants argue (brief, page 21) that "the side location of appellants' opening constitutes more than a 'mere shifting location of parts' as asserted by the Examiner" since "this side location allows the observation window and the user interface surface to be located in the same area." According to appellants (brief, page 21) this "represents a substantial improvement over the design of the Christie et al. device." Appellants conclude (brief, pages 21 and 22) that the examiner has failed to establish a prima facie case of obviousness with respect to claim 1.

We agree with appellants' arguments. The obviousness rejection of claim 1 is reversed because of lack of evidence or a convincing line of reasoning to support any of the examiner's assertions.

Turning next to the obviousness rejection of claims 1 through 11 and 13 through 15 based upon the teachings of Permut, the examiner acknowledges (answer, pages 5 and 6) that Permut does not have a side opening in the housing, but concludes (answer, page 6) that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the 'rear' opening of Permut on a side portion of the housing" because "providing the opening on the side of the housing as opposed to the rear would have resulted through routine experimentation and optimization, lacking any unobvious or unexpected results." The examiner likewise acknowledges (answer, page 6) that Permut is "expressly silent as to the step of checking for proper insertion," but nevertheless concludes (answer, page 6) that "such a step would have been considered inherent to the assembly thereof." If such a step is not inherent, then the examiner indicates (answer, pages 6 and 7) "it would have been considered obvious to one having ordinary skill in the art at the time the invention was made to have provided such a step because having such a step would have obviated handling errors from the picker assembly, as would have been realized by one having ordinary skill in the art."

\*4 Appellants argue (brief, page 32) that the examiner has failed to provide any evidence, whatsoever, in support of the positions taken in the rejection, and that there is nothing in the record to support the rejection. We agree. In view of the lack of such evidence, and the lack of a convincing line of reasoning to support the rejection, we will reverse the obviousness rejection of claims 1 through 11 and 13 through 15 for lack of a prima facie case of obviousness.

The obviousness rejection of claim 12 is reversed because the teachings of Jenkins do not cure the noted shortcomings in the teachings of Christie. In addition, the obviousness rejection of claims 12 and 16 is reversed because the teachings of Jenkins do not cure the noted shortcomings in the teachings of Permut.

## DECISION

The decision of the examiner rejecting claims 1 through 16 under 35 U.S.C. § 103(a) is reversed.

## REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

KENNETH W. HAIRSTON

Administrative Patent Judge

JERRY SMITH

Administrative Patent Judge

LEE E. BARRETT

Administrative Patent Judge

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